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08/124,616 09/22/93 GRUBE

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G CM01946H

EXAMINER

CHOULES, J

ART UNIT

PAPER NUMBER

2307

DATE MAILED:

04/17/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1/30/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 day(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 to 8, 17 to 18 and 21 to 24 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1 to 8, 11 to 18, and 21 to 24 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☒ Other

SEE ATTACHED

EXAMINER'S ACTION

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Part III DETAILED ACTION

15. Claims 1-8, 11-18, and 21-24 are presented for examination.

16. The text of the Title 35, U.S. Code and the text of the rejections not in this action can be found in the prior Office Action, mailed December 7, 1994, and are incorporated by reference.

Response to Amendment

17. Applicant's arguments filed January 30, 1995 have been fully considered but they are not deemed to be persuasive as noted below.

18. The Objection to the specification under 37 CFR 1.73 Summary of the invention is maintained. Although the applicants discussion of 37 CFR 1.77 is interesting it is irrelevant as this portion of the law was not cited in the previous office action. 37 CFR § 1.73 Summary of the invention. clearly states:

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

The examiner requires a summary in the present application, the applicant is reminded no new matter should be added.

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19. The 102 rejection based on Williams, patent no. 5,057,935 now applies only to claim 21, 23, and 24 as claim 11 is now combined with claim 19 and the 103 rejection used for claim 19 now applies to claim 11. The applicant provides the following arguments against the art of Williams:

- a. The E-Mail agents of Williams do not equate to computers or servers of the present invention.
- b. Williams gathers information on setting a flag while the present invention gathers information continuously.
- c. Williams determines the requester while the present invention determines who to send to from the saved information and determines if the transmission will take place and what to transmit.
- d. Transmitting of Williams is based on received information while the user information of the present invention is not.
- e. The word automatically is not supported by Williams specification.
- f. Williams does not teach displaying.

20. In respect to the applicants arguments to traverse the 102 rejection based Williams the examiner respectfully disagrees as follows:

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a. First whether the E-Mail agents of Williams equate to servers is irrelevant as this art was not used in a rejection of claim 1. Secondly the E-Mail agents of Williams run on a network of computers (see figure 1). Third to the assertion the computers of the present invention collect network information could generally be interpreted as any information having to do with the network which Williams covers. The specification states "Network information 126 includes configuration information and statistical information." (emphasis added page 5, line 24) This indicates to the examiner that the network information is possibly configuration information or statistical information but may include other types of information. Further evidence of this position is claim 12 a dependent claim from claim 11 and further specifies "network information as at least one of configuration information or statistical information". In the case of the present invention the information collected is elemental statistical information as it conveys information on how many people received the message sent and how many of the people that where the intended recipients received the message.

b. The applicant states that the present invention gathers continuously however there is no evidence that the *claimed invention* does this in fact claim 21 specifies "collection on an event" and claim 23 further specifies that the event may be "a response to a request" Williams setting of a flag is a request

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and the information is collected in response to that request. The other claims contain no language to specify when the collection will take place. The applicant misinterprets the principle that claims are interpreted in the light of the specification. Although continuous retrieval may be found as an example or embodiment in the specification, it was not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims.

c. While it is true that Williams determines who the requester is as was so eloquently argued by the applicant (paragraph 6 of the amendment filed January 30, 1995) "The request would be received by the host and stored as all information is. Based on the forgoing text, it will be understood that the determination of who and what information to send is always made based on stored information in the host. The request is simply another way to enter stored information (in addition to receiving network information)." In response to Applicant's argument that the present invention determines if and what, applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements may be found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the

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words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims.

d. The specification states "User information 127-130 includes customer information which may be bug reports, bug fixes, updates of software applications, free software, pricing information, and enhancements of existing software applications." User information could be any information of pertaining to of interest to the user customer information adds no further meaning other than to indicate the user is the customer which is true on a network. The "bug reports" etc. are merely examples of what the information may be but are not limiting on other information that may be of interest to the user. Clearly the information specifying if his messages were received is of interest to the user or he would not of requested it. Although the examples and embodiments of the specification may employ user information that is not derived from network information there is nothing in the language of the claims or the specification that requires this limitation.

e. The claims of Williams have been patented and are valid prior art the examiner will not entertain arguments against the validity of said claims. See 35 U.S.C. 282.

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f. It is clearly implicit that the user information is displayed in the system of figure 1 of the Williams patent otherwise the user could not reference it the specific definition of user information is treated in the paragraphs hereinabove.

21. Jain, patent number 5,193,151 was combined with Williams for a 103 rejection of claim 22, applicant attempts to traverse this argument by stating that "the present invention uses two wireless communication channels. One is shared (many-to-one) for computer-to-host" "the other is a one to many channel" (paragraph 8). However claim 22 clearly specifies in its present form "at least one wireless communication channel." Thus clearly the one channel of Jain fits with its satellite links which are wireless. There are no further restrictions specified in claim 22 or any of the other claims regarding the communication channels. The applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements (two wireless communication channels, a many to one channel and a one to many channel) may be found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms.

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22. Claims 1-3, 5-6, 8, 11-13, 15-17, 21, and 23-24 were rejected under section 103 as being unpatentable over Doelz, patent no. 4,156,789 and Irby, III et al, patent number 5,021,949 now further in combination with Jain because of changes in the independent claims. Applicant put forth the following arguments against these rejections:

a. Doelz, node responses are in response to a poll, in the present invention network automatically sends information.

b. Determining not described by Doelz.

c. Wireless communication is not described by Doelz.

d. The determining of Irby "compares an inbound subscriber request" with a list of information verses subscriber address.

e. Irby's information is same as received so is not user information as in the present invention.

f. Irby's marketing information is based on current and future statistics while present invention is on past information.

23. The examiner disagrees on all points as follows.

a. Doelz, node responses are in response to a poll, and in the present invention "the transmission may be initiated in response to the host computer sending a request for information transmission" (page 8, lines 13-15) also in claims 5 and 15 recite "a request from the host computer" a poll is in a request from the host computer.

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b. and c., These elements are covered by the combination. In response to Applicant's piecemeal analysis of the references, one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. Specific arguments are given discussing the art that applies to these elements.

d. and e. The determining of Irby compares stored information a list of information verses subscriber address (which as the applicant pointed out in paragraph 6 of the amendment does not need to be the collected information) to the "inbound subscriber request" other stored information to decide who to send "user information" which as discussed in paragraphs hereinabove is not restricted from being a portion of the information that is collected from the network. It is noted even things like bug reports may be generated from information collected from the network.

f. It is clear that as Irby's statistics take time to collect and compile as they are stored in the database they are also a history of past information even projected demand is passed projected demand.

24. Claims 4 and 14 were rejected under section 103 as being unpatentable over Doelz, and Irby, III et al, now in combination with Jain and in view of Ellison et al., *"Reap the rewards of LAN*

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inventory programs". Applicant put forth the following arguments against these rejections:

a. Ellison does not address, usage statistics, or determining.

b. Ellison describes a process of verifying that is different from that of the invention as it "does not describe verifying that a particular computer has or does not have a particular application".

25. The examiner disagrees on all points as follows.

a. In response to Applicant's piecemeal analysis of the references, one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.

b. To verify that a network does not have more than a the number of users allowed by a site license it must first verify that a particular computer does or doesn't have a particular application. Furthermore, Ellison describes verifying if a copy is licensed or not by checking the software serial number (page 2, lines 26-28). Again Applicant misinterprets the principle that claims are interpreted in the light of the specification.

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26. Claims 7 and 18 were rejected under section 103 as being unpatentable over Doelz, and Irby, III et al, now in combination with Jain and in view of Ogaki et al., patent no. 4,654,799. Applicant argues that the software vending machine of Ogaki et al. does not provide price information to the computer "being considered to receive and use the new software". The language of the claims (7 and 18 as well as 1 and 11) does not indicate that the price is displayed at the computer the software is to be used at it simply requires that the price information be displayed for the user which the present combination of the art shows.

Claim Rejections - 35 USC § 102

27. Claims 21, 23 and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Williams patent no. 5,057,935.

28. As to claims 21, Williams taught a system comprising the steps of "upon occurrence" (col. 5 lines 4-7); "upon receiving" (col. 5, lines 7-9 and col. 3 lines 9-14); "determining" (col 5, lines 59-60 and col. 2, lines 24-29); and "transmitting" (col 5, lines 59-60 and col. 2, lines 24-29 and col. 3 lines 9-14).

29. As to claim 23, Williams taught "response to a request" (col. 4, line 62 through col. 5, line 7).

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30. As to claim 24, Williams taught "plurality of computers" (col. 2, lines 57-68).

Claim Rejections - 35 USC § 103

31. Claim 11 and rejected under 35 U.S.C. § 103 as being unpatentable over Williams patent no. 5,057,935 in view of Jain patent no. 5,193,151.

32. As to claims 11, Williams disclosed the invention substantially as claimed including a data processing system ['DP'] comprising the steps of "transmitting by the plurality" (col. 5 lines 4-7); "upon receiving" (col. 5, lines 7-9 and col. 3 lines 9-14); "determining" (col 5, lines 59-60 and col. 2, lines 24-29); "transmitting, by the host" (col 5, lines 59-60 and col. 2, lines 24-29 and col. 3 lines 9-14); and "after receiving" (col. 2, lines 24-29) for the user to reference thereto the status log must implicitly be transmitted and displayed.

33. Williams does not detail "wireless communication channels". Jain describes a system which includes "wireless communication channels" (col. 11, lines 27-40). Williams does not detail clearly that a network server or host would contain the status log. Network hosts are well known in the DP art. It would have been obvious if not implicit to one of ordinary skill in the DP

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art at the time of the applicants invention to put the status log on the host because Williams states that "data objects", which would include the status log as it is an object that contains data, are "stored within a storage device 14 which is associated with a resource manager" clearly the resource manager that would save a log containing information relevant to the network would be the network host.

34. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Jain with Williams because it is well known in the art that wireless communication allows such as radio or satellite allow a widely distributed network or set of networks with relative low cost in adding new continuously connected nodes as compared with direct wired systems improving the versatility of the DP system.

35. Claims 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Williams as applied to claims 21 above, and further in view of Jain patent no. 5,193,151.

36. As to claim 22, Williams does not detail "wireless communication channels". Jain describes a system which includes "wireless communication channels" (col. 11, lines 27-40).

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37. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Jain with Williams because it is well known in the art that wireless communication allows such as radio or satellite allow a widely distributed network or set of networks with relative low cost in adding new continuously connected nodes as compared with direct wired systems improving the versatility of the DP system.

38. Claims 1-3, 5, 6, 8, 11-13, 15-17, and 21-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Doelz patent no. 4,156,789 in view of Irby, III et al. patent no. 5,021,949 and also in view of Jain patent no. 5,193,151.

39. As to claims 1, 2, 5, 6, and 8, Doelz disclosed the invention substantially as claimed comprising the steps of "transmitting by the servers" (col. 14 lines 27-32, see also col. 7, lines 63-68); "upon receiving" (col. 14, lines 27-34) the data is to be sent to the host then on demand sent to the network it must be stored in the host; "transmitting, by the host" (col. 14, lines 32-34); and "after receiving" implicitly data sent to a network terminal may be displayed.

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40. Doelz does not detail "determining". Irby, III et al.. describes a system which includes "determining" (col 1, line 65 through col. 2, lines 12). Doelz and Irby, III et al. do not detail "wireless communication channels". Jain describes a system which includes "wireless communication channels" (col. 11, lines 27-40).

41. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Doelz and Irby, III et al. because determining based on the data collected makes the system responsive to the needs of the user or remote computer improving the versatility of the DP system.

42. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Jain with Doelz and Irby, III et al. because it is well known in the art that wireless communication allows such as radio or satellite allow a widely distributed network or set of networks with relative low cost in adding new continuously connected nodes as compared with direct wired systems improving the versatility of the DP system..

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43. As to claims 11, 12, and 15-17, See the above paragraphs as much of the claim is similar the difference being that only a single network is claimed and transmitting to the network host or 'master node'. Doelz describes "transmitting, by a plurality" (col. 13, lines 59 through col. 14, line 28) and "upon receiving" (col. 13, lines 64-67)

44. As to claims 3 and 13, Irby, III et al. discloses "user marketing reports" (col. 1, line 40 through col. 2, line 11).

45. As to claim 21 and 22, see paragraphs hereinabove which refer to claim 1 and 11 as claims 21 and 22 are broader than these claims.

46. As to claim 23, Doelz taught "response to a request" (col. 14, line 28-34).

47. As to claim 24, Doelz taught "plurality of computers" (col. 2, lines 57-68).

48. Claims 4 and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Doelz, Irby III et al., and Jain as applied to claims 1 and 11 respectively above, and further in view of Ellison et al., *Reap the rewards of LAN inventory programs*.

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49. As to claims 4 and 14, Doelz, Irby III et al., and Jain do not detail "software authorization". Ellison et al. describes a system which includes "software authorization" (on Dialog printout page 4, lines 39-41).

50. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Ellison et al. with Doelz, Irby III et al. and Jain because tracking software authorization on the system allows administrators to locate users that have not gained proper authorization for the software they are using improving the versatility of the DP system.

51. Claims 7 and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Doelz, Irby III et al., and Jain as applied to claims 1 and 11 respectively above, and further in view of Ogaki et al. patent no. 4,654,799.

52. As to claims 7 and 18, Doelz, Irby III et al., and Jain do not detail "pricing information". Ogaki et al. describes a system which includes "pricing information" (col. 11, lines 39-47).

53. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the

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teachings of Ogaki et al. with Doelz, Irby III et al., and Jain because tracking software authorization on the system allows administrators to locate users that have not gained proper authorization for the software they are using improving the versatility of the DP system.

Conclusion

54. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tseung 5,036,518 Wireless many to one etc.

55. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

56. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack

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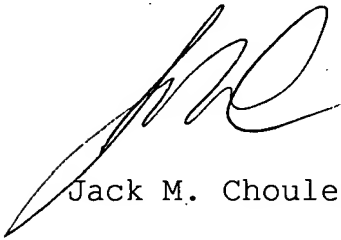
-19-

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Choules whose telephone number is (703) 305-9840. The examiner can normally be reached on Monday-Friday from 7:15 AM - 3:45 PM and generally on Monday and Wednesday until 5:45.

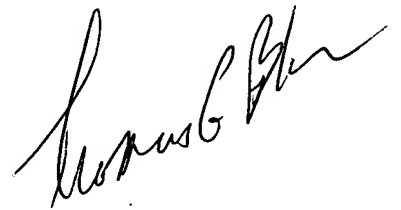
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached at (703)-305-9707. The fax phone number for this Group is (703)-305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.



Jack M. Choules

April 10, 1995



THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 2300